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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/525,252

09/19/2005

Jean-Marie Basset

0512-1264

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466

7590

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YOUNG & THOMPSON

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EXAMINER

SAVAGE, MATTHEW O

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/525,252	<b>Applicant(s)</b> BASSET ET AL.	
	<b>Examiner</b> Matthew O. Savage	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2-22-05</u> .   | 6) <input type="checkbox"/> Other: _____                          |

The information disclosure statement filed on 2-22-05 has not been considered since copies of the foreign references cited therein were not provided.

Applicant's election with traverse of group I, nickel as the metal  $M_h$ , nickel as the metal  $M_i$ , and industrial water in the reply filed on 4-28-08 is acknowledged. The traversal is on the ground(s) that the groups and species are intimately related so that no undue burden would be imposed on the examiner in the case all of the groups and species were examined together. This is not found persuasive because examination of nine species of  $M_h$ , seventy five species of  $M_i$ , and method, and apparatus claims in a single application would impose a serious burden upon the examiner and because the common inventive feature shared by the groups is known in the art.

The requirement is still deemed proper and is therefore made FINAL.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 14, the claiming of one range within another is considered vague and indefinite. It is suggested that the ranges be claimed in separate claims.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Niebylski.

With respect to claims 1, 7, and 8, Niebylski discloses a method that obviously reduces the content of metals in ionic form present in an aqueous effluent in the form of a plating solution since the ions will be plated onto a surface, the method including placing the aqueous effluent, including a metal (e.g., palladium) in ionic form, in contact with at least a metal (e.g., nickel) completely or partially coated with hydrogen before (e.g., by treatment with nitric acid) and during the placing in contact with the metal ion(s) (e.g., the hydrogen ions in the plating solution); and b) recovering the aqueous effluent (e.g., in a container where the plating solution is carried out).

As to claims 2-6, Niebylski discloses nickel.

Regarding claims 9 and 10, Niebylski discloses palladium.

Concerning claim 11, Niebylski discloses platinum.

As to claims 9-12, the selection of nickel would have been obvious since nickel ions will preferentially plate a nickel base metal.

Regarding claim 13, Niebylski discloses a support (e.g., nickel coated wires).

As to claim 14, Niebylski discloses a range of 25-75 degrees C which falls within the claimed range.

Concerning claim 15, Niebylski discloses a pH range of 2-6.5 which falls within applicants claimed range.

Regarding claim 16, Niebylski discloses a plating solution that is considered industrial water.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 7,393,454.

Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claim 1 of the patent recites reducing the content of metals in solutions by placing a metal treated with hydrogen in contact with the solution and recovering the solution as recited in instant claim 1;

Concerning instant claims 2-6, claim 5 of the patent recites nickel;

As to claim 7, claim 1 of the patent recites coating the metal with hydrogen before contact with the solution;

Regarding claim 8, claim 1 recites coating the metal with hydrogen during contact with the solution since the solution would include dissociated hydrogen ions;

Concerning claims 9-12, claim 2 of the patent recites zinc, and the selection of nickel is considered obvious since a nickel base metal will be preferentially coated when placed in contact with nickel ions;

As to claim 13, claim 8 of the patent recites a support;

Claims 13 and 14 recite the temperature ranges recited in claim 14;

The patent claims fail to specify the range of pH values (1-14) recited in claim 15, however, the selection of such values would have been obvious in order to optimize the process for a particular application;

Patent claim 1 recites "a contaminated solution" but fails to recite "industrial water" as recited in claim 16, however, such a selection is considered obvious since "industrial water" is typically "a contaminated solution".

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Any inquiries concerning this application should be directed to Matthew Savage who can normally be reached at 571-272-1146 between 9:00 am and 5:30 pm.

/Matthew O Savage/

Primary Examiner, Art Unit 1797